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OFFICE OF PETITIONS

ON PETITION

In re Application of
Harrison
Application No. 08/919,450
Filed: 28 August, 1997
Attorney Docket No.: 10547.15US1

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This is a decision on the petitions:

- filed on 29 January, 2001, and refiled via FAX on 4 November, 2002, to Withdraw the Holding of Abandonment under 37 C.F.R. §1.181,¹ and
- filed on 6 November, 2002, alternatively under 37 C.F.R. §1.137(b)² to revive the above-identified application.

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

² Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

For the reasons set forth below, the petition:

- to revive under 37 C.F.R. §1.137(b) is **GRANTED**;³ and
- treated as a request to Withdraw the Holding of Abandonment under 37 C.F.R. §1.181 is **DISMISSED**.⁴

BACKGROUND

The record indicates that:

- it appeared that Petitioner failed to pay timely the Issue Fee in response to the Notice of Allowance and Issue Fee Due mailed on 6 July, 1999, and due under a non-extendable deadline on or before 6 October, 1999;
- the application was deemed abandoned after midnight 6 October, 1999;
- the Notice of Abandonment was mailed on 29 December, 1999;
- in contrast, Petitioner's date-stamped (5 October, 1999) receipt card confirms that a request for a continued prosecution application (CPA) was timely filed and Office records indicate that Petitioner was charged the fee therefor;
- however, Petitioner appears to have failed to respond to the Notice of Abandonment until on or about 29 January, 2001--thirteen months after the abandonment was Noticed--at which time Petitioner sought to have the Holding of Abandonment withdrawn;
- on 6 November, 2002, Petitioner filed the petition (with fee authorization) to revive under 37 C.F.R. §1.137(b), and set forth therein the required statement of unintentional delay (the statement), and cited therein to the previously filed CPA (the reply).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

³ Pursuant to Petitioner's authorization, the petition fee (\$1,280.00) is charged to Deposit Account 01-1156.

⁴ Pursuant to Petitioner's authorization, the petition fee (\$130.00) is charged to Deposit Account 01-1156.

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁵

The regulations at 37 C.F.R. §1.137 set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁶

Delays in responding properly raise the question whether delays are unavoidable.⁷ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁸ Petitioner must be diligent in attending to the matter.⁹ Moreover, it long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.¹⁰ The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.¹¹ Failure to do so does not demonstrate the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and

⁵ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁶ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁷ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁸ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁹ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

¹⁰ See: *In re Application of S*, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

¹¹ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹²

Allegations as to Withdrawal
of the Holding of Abandonment

Petitioner makes no showing as to a basis for the delay of thirteen months between the mailing of the Notice of Abandonment and the filing of a petition to have the holding withdrawn¹³ as contrast with the regulatory requirement that the matter be raised within two (2) months of the action complained of.

While there may have been a lapse or mistake by counsel, it in no way satisfies the Pratt showing required herein.

More than 35 years ago the Court of Customs and Patent Appeals warned practitioners in Lorenz v. Finkl¹⁴ that "ordinary prudence" demands that they take "appropriate action" as directed by the Office, and practitioners disregard this warning at peril to their client's matters. (Moreover, as long as the attorney/agent has not acted to deceive the client,¹⁵ the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client who hired the attorney/agent.¹⁶)

The courts have determined the construct for properly supporting a request to withdraw a holding of abandonment.¹⁷

As is clear, Petitioner fails to satisfy the burdens set forth in Delgar v. Schulyer. Withdrawal of the holding of abandonment is not appropriate and hereby is dismissed.

¹² Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

¹³ See: *inter alia*, "Resetting Period for Reply and Remailing and Remailing Office Communications when Outgoing Office Mail is Delayed" (PDF) at: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/kuninmemos.htm>

¹⁴ Lorenz v. Finkl, 142 USPQ 26, 27-28 (CCPA 1964).

¹⁵ When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

¹⁶ The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962). The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

¹⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Allegation of Unintentional Delay

Petitioner has filed a petition and fee under 37 C.F.R. §1.137(b), and stated therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

Therefore, the petition under 37 C.F.R. §1.137(b) hereby is **granted**.

This matter is forwarded to Technology Center 2700 for processing of the CPA and further examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.



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